

Appl. No.: 10/689,955
Applicant(s): Mileos et al.
Filed: October 21, 2003

REMARKS/ARGUMENTS

In the January 14, 2005 Office Action, the Examiner rejected claims: as not enabled; as indefinite; for double patenting; as anticipated; and as obvious. The Applicants respectfully traverse the Examiner's rejections and submit that any proper basis has been obviated by the present amendments; or that the rejection must be withdrawn.

The Applicants further respectfully submit that the present amendments put the application in better condition for appeal.

Allowable Subject Matter

The Applicants also wish to acknowledge that the Examiner found that Claims 101 and 102 would be allowable if rewritten or amended to overcome the section 112, second paragraph rejections. In view of the present amendments, the Applicants respectfully submit that these claims are in condition for allowance.

Support for the Present Amendments

The present communication amends Claims 2-9, 11, 13-14, 18-20, 22, 24, 48, 65, 85, 86, 92, 95, 98, 99, 100, 101 and 102. The Applicants respectfully submit that each of the present amendments is adequately supported by the above-identified application as originally filed.

The amendments to Claims 2-9, 11, 13-14, 18-20, 22, and 24 merely change the dependence from claim 1 to claim 101. As Examiner Morrison found that Claim 101 was

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a substantial duplicate for now cancelled Claim 1, the Applicants respectfully submit that no further support is needed.

Claim 48 was amended to explicitly state what had been implicit in this claim as originally filed. Thus, the Applicants respectfully submit that original Claim 48 provides sufficient support for amended Claim 48. Moreover, this amendment does not narrow Claim 48.

Claim 65 was amended to explicitly state what had been implicit in this claim as originally filed. Thus, the Applicants respectfully submit that original Claim 65 provides sufficient support for amended Claim 65. Moreover, this amendment does not narrow Claim 65.

For instance, as amended, Claim 85 is directed to the device of Claim 1 (without further amendment) further comprising "a first inclined surface for engagement supported by said side arm." This aspect of the claimed subject matter is illustrated, for instance, in Fig. 11, as originally filed. Thus, this amendment is adequately supported by the above-identified application as originally filed.

Claim 86 was amended to explicitly state what had been implicit in this claim as originally filed. Thus, the Applicants respectfully submit that original Claim 86 provides sufficient support for amended Claim 86. Moreover, this amendment does not narrow Claim 86.

Claim 92 was amended to explicitly state what had been implicit in this claim as originally filed. Thus, the Applicants respectfully submit that original Claim 92 provides sufficient support for amended Claim 92. Moreover, this amendment does not narrow Claim 92.

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As amended, Claims 95, 98, 99, and 100, each recite "side pieces defining aligned apertures on opposite sides of the center section". Such apertures are illustrated, for instance, in Fig. 4, as originally filed. Thus, this amendment is adequately supported by the above-identified application as originally filed.

As amended, Claim 101 no longer recites that "the front end [of said mounting bracket] being closer to the front of the desk than the back end". The structure of Claim 101 is illustrated throughout the above-identified application, including, for instance, in Fig. 1. Thus, this amendment is adequately supported by the above-identified application as originally filed.

As amended, Claim 102 no longer recites the phrase "the fourth pivot point". Instead, Claim 102 recites the phrase "the fourth point". The Applicants respectfully submit that the ninth line of Claim 102, which recites "a fourth point" provides sufficient antecedent for the amended limitation. Furthermore, the Applicants respectfully submit that the structure of Claim 102 is illustrated throughout the above-identified application, including, for instance, in Fig. 1. Thus, this amendment is adequately supported by the above-identified application as originally filed.

The Enablement Rejections

The Examiner rejected Claims 95 - 100 as not enabled. While the Examiner acknowledges that the drawings show shelf bracket (4) includes two side pieces, the Examiner alleges that "the drawings do not teach "slots" on opposite sides of the center section. (Office communication at page 2-3) The Applicants respectfully traverse.

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Nonetheless, to expedite prosecution of the above-identified application, but not to disclaim any subject matter, the Applicants have amended these claims to recite the word "apertures" instead of the objected word "slots". Clearly, Fig. 4, among figures, shows apertures on opposite sides of the center section. Thus, the present rejection is not well founded and should be withdrawn.

The Indefiniteness Rejections

Claims 101 and 102

Claim 101

The Examiner rejected Claim 101 as indefinite because this claim to a sub-combination mentions the desk (which is not a part of the sub-combination) in identifying the orientation of part of the claimed sub-combination. By the present amendment, the Applicants have deleted this reference to the desk in describing the claimed sub-combination. In view of this amendment, the Applicants respectfully submit that they have obviated any basis for the rejection of this claim under the second paragraph of section 112.

Claim 102

The Examiner alleges that there is insufficient antecedent basis for the limitation "the fourth pivot point" in lines 10-11 of Claim 102. The Applicants respectfully traverse.

Nonetheless, to expedite prosecution of the above-identified application, the Applicants have amended the limitation to merely recite "the fourth point", which phrase has sufficient antecedent in the phrase in line nine which recites "a fourth point".

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Consequently, the Applicants respectfully submit this ground for rejection has been obviated.

The Double Patenting Rejection

The Examiner provisionally rejected Claims 1 and 31 as double patenting over Claims 101 and 102. The Applicants have cancelled Claims 1 and 31, which the Applicants submit renders the double patenting rejection moot. The Applicants respectfully submit that in view of the cancellation of Claims 1 and 31, this rejection should be withdrawn.

The Anticipation Rejections

The Examiner rejected Claims 48, 49 and 92 as anticipated by U.S. Patent No. 5,302,015 to Du Vall. The Examiner also rejected claims 48, 83, 86, 87 and 94 as anticipated by U.S. Patent No. 4,644,875 to Watt. The Applicants respectfully traverse the Examiner's anticipation rejections.

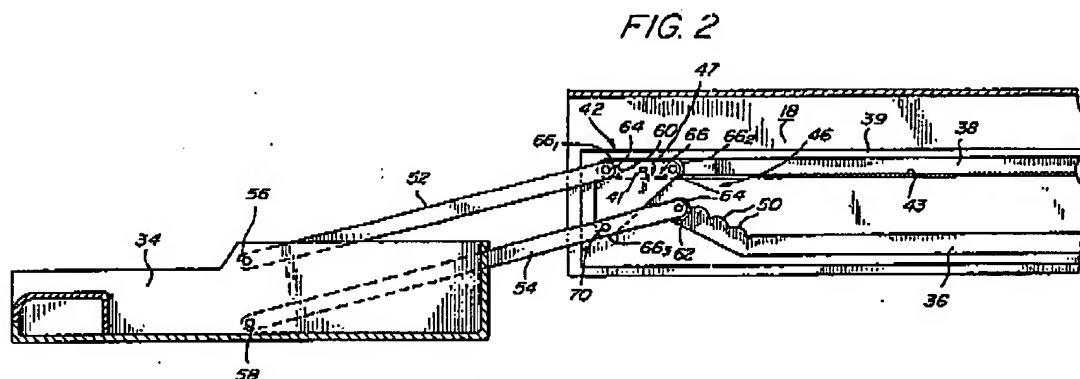
The Du Vall Anticipation Rejection

The Examiner rejected Claims 48, 49 and 92 as anticipated by U.S. Patent No. 5,302,015 to Du Vall. *Inter alia*, the Examiner asserts that the Du Vall discloses a "linkage is attached to the shelf (14) at a substantially centralized, interior point of the auxiliary shelf removed from the side edges (i.e. the links 52, 54 are attached to the shelf along the central longitudinal axis thereof, which is located interior of side edge 30 and the opposite side edge of the shelf) in a manner to prevent the shelf mechanism from

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extending below the bottom surface of the shelf (see Fig. 2)." Office Communication at 4.

The Applicants respectfully submit that the Examiner has misconstrued the cited reference. Instead of the linkage attachment being at a substantially centralized interior point, the linkage is actually attached on the exterior of the shelf. Indeed, the only support the Examiner cites for her findings, findings that are arbitrary, capricious, and an abuse of discretion, is Fig. 2 of the Du Vall patent, which is reproduced below.

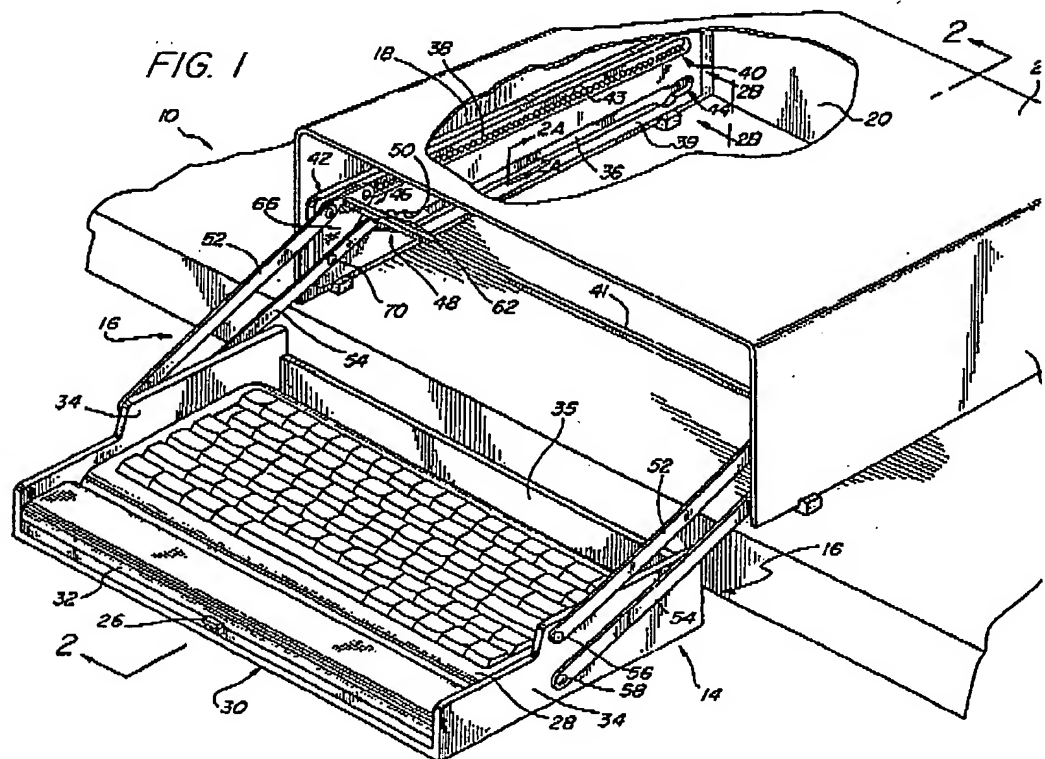


Alone, at best, Fig. 2 of the Du Vall patent is ambiguous. This figure does not support the Examiner's position because, while Fig. 2 clearly indicates that links 52 and 54 are on the other side of *side wall 34* (34 is identified as a side wall by Du Vall at, for instance, col. 3, ln. 64) – those portions of links 52 and 54 that overlap side wall 34 are shown in dotted lines to indicate they are on the other side of side wall 34. Consequently, one of ordinary skill cannot determine where on shelf 30 side wall 34 is located from Fig. 2 alone.

The Applicants respectfully submit that the Du Vall reference is more than just Fig. 2. Indeed, "[a] reference, however, [be] considered for all it taught, disclosures that

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diverged and taught away from the invention at hand as well as disclosures that pointed towards and taught the invention at hand." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281 (Fed. Cir. 1985) quoting *W.L. Gore & Associates, Inc. v. Garlock Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983), cert. denied, 105 S.Ct. 172 (1984). To understand Fig. 2, the Applicants respectfully submit that one must use Fig. 1 (which is reproduced below in pertinent part) of the Du Vall patent as a guide.



Indeed, Du Vall states that "FIG. 2 is a side cross-sectional view of the embodiment of FIG. 1 taken along line 2--2". Col. 2, ln. 65-66. In this context, the Applicants respectfully submit that left side links 52 and 54 of the device disclosed in the Du Vall patent are on the extreme lateral exterior of shelf 30, beyond side wall 34. This

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extreme lateral exterior position for attaching the links to the shelf structure is expressly illustrated on the right side of the Du Vall device in Fig. 1.

Moreover, the Du Vall device could not hold keyboard 28 if any of side links 52 or 54 were attached at "a substantially interior point of said auxiliary shelf removed from the side edges of said auxiliary shelf" because such a link-shelf connection would preclude keyboard 28 from sitting on shelf 30.

In view of the above, the Applicants respectfully submit that the Examiner's findings based upon the Du Vall patent are arbitrary, capricious, and an abuse of discretion. Consequently, these findings, and the erroneous holding of anticipation (as well as the erroneous holding of obviousness) based on these findings, must be withdrawn.

The Watt Anticipation Rejection

As noted above, the Examiner also rejected claims 48, 83, 86, 87 and 94 as anticipated by U.S. Patent No. 4,644,875 to Watt. *Inter alia*, , the Examiner asserts that Watt teaches "connect[ing the linkage arms to the] shelf bracket/auxiliary shelf (22) having . . . two side edges (at 22 and the edge opposite 22), . . . wherein the linkage arms (76, 78) connect to the auxiliary shelf/shelf bracket (22) removed from the two side edges (see Fig. 2.) and near (defined by Merriam Webster's Collegiate Dictionary as "close to") the middle (defined by Merriam -Webster's Collegiate Dictionary as "something intermediate between extremes")" Office Communication at 5.

The Applicants respectfully submit the Examiner has misconstrued both the Watt reference and the English language. The Applicants further submit that when the Watt

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reference is properly construed (*i.e.*, as one of ordinary skill would understand this reference), it teaches away from the claimed subject matter. Consequently, the Watt reference does not disclose, *and thus cannot anticipate*, the claimed subject matter.

The Examiner's use of the cited dictionary definitions of the words "near" and "middle" render these words trivial. As best as the Examiner's use of these words is understood by the Applicants, something on the outer edges of a twelve-foot wide surface is "near the middle" of the surface, because two millimeters inside a twelve foot surface is fully two millimeters from the outer edge, and thus intermediate between the extreme edges of the surface. Moreover, as the extremity is only two millimeters away from this intermediate point, the extremity is "near the middle".

While Lewis Carroll (the mathematician who wrote, among things, *Alice Through the Looking Glass*) might have appreciated this analysis, the Applicants respectfully submit that one of ordinary skill in the relevant art would not consider an extremity to be near the middle of a surface because it is only two millimeters away from some point that itself is not an extremity. Rather, the Applicants respectfully submit that to one of ordinary skill, the phrase "near the middle" connotes a position that (a) is not in contact with an extremity, and (b) approaches the midline of the surface. When such an understanding of the phrase "near the middle" is used, it is clear that Watt does not teach positioning the linkage arms "near the middle". Rather, Watt teaches positioning the linkage arms at the lateral extremities. Thus, Watt does not anticipate, but instead teaches away from the claimed subject matter.

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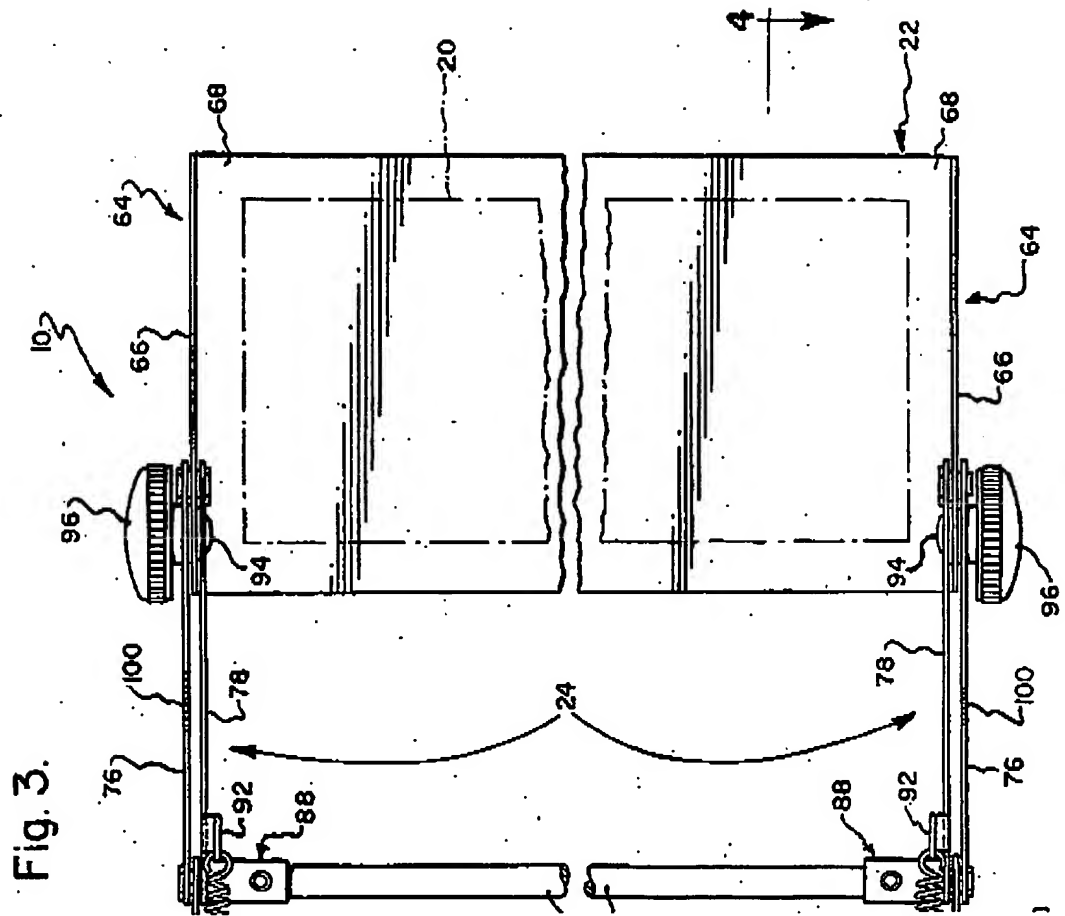
The only citation the Examiner makes to the Watt reference to support her contention concerning the lateral positioning of the linkage arms with respect to their shelf bracket attachment points is Fig. 2.

The Applicants respectfully submit that Fig. 2 is a "side elevational view". Col. 2, lines 11-16 ("*Fig. 1 is a side elevational view . . . Fig. 2 is a view similar to Fig. 1 . . .*" Emphasis added.) Because Fig. 2 is a side elevational view, *one cannot ascertain (from this figure) whether the linkage arms connect to the shelf are at, or are away from, the extreme side edges of the shelf.* Indeed, the Watt reference does not even state from where the view of Fig. 2 was taken.

However, Fig. 2 does provide information that is inconsistent with finding that the Watt reference teaches attaching the linkage arms "near the middle" of the shelf. Specifically, Fig. 2 identifies the plane of view for, *inter alia*, Figs. 3 and 7. Any evaluation of Fig. 2 concerning the position of the attachment between the **links (76 & 78) and upstanding plate portions 66** without due consideration of both Figs. 3 and 7 is arbitrary, capricious, and an abuse of discretion.

In contrast to the unknown position of the view upon which the Examiner relies — Fig. 2 —, Fig. 3 is a view taken in a plane just above the auxiliary shelf. See line 3—3 in Fig. 2. Consequently, Fig. 3 (unlike Fig. 2 upon which the Examiner improperly relies) shows the relationship of the linkage arms (76 & 78) to the edges (**upstanding plate portions 66**) of the shelf bracket of the device disclosed in the Watt patent. In Fig. 3 (reproduced below in pertinent part) it is apparent that the linkage arms (76 and 78) are attached to **upstanding plate portions (66)** at (one arm on either side of the upstanding plate), and not away from, the side edges (64).

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Thus, when the Watt reference is properly applied, it does not teach the subject matter of Claims 48, 83, 86, 87 and 94. Therefore the anticipation rejection based upon Watt must be withdrawn.

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The Obviousness Rejections

The Examiner set forth five sets of arguments asserting that most of the claims are obvious, and thus unpatentable, under 35 U.S.C. § 103.

Specifically, the Examiner asserts that U.S. Patent No. 5,292,097 to Russell in view of U.S. Patent No. 5,257,767 to McConnell renders the subject matter of 1-7, 9-15, 17-30, 32-37, 39-47, 50-64, 84, 85, 89, 91, and 95-100 obvious. The Examiner then asserted that U.S. Patent No. 5,292,097 to Russell in view of U.S. Patent No. 5,257,767 to McConnell in further view of U.S. Patent No. 5,031,867 to Cotterill rendered Claims 16 and 38 obvious. The Examiner continued by asserting that U.S. Patent No. 5,292,097 to Russell in view of U.S. Patent No. 4,644,875 to Watt rendered Claim 65-69 and 73 obvious. The Examiner further asserted that U.S. Patent No. 5,292,097 to Russell in view of U.S. Patent No. 4,644,875 to Watt in further view of U.S. Patent No. 5,257,767 to McConnell rendered Claims 70-72 and 74-82 obvious. The Examiner concluded by asserting that U.S. Patent No. 4,644,875 to Watt in view of U.S. Patent No. 5,257,767 to McConnell rendered Claims 90 and 93 obvious.

The Applicants respectfully traverse the Examiner's assertions and submit that none of the cited references, alone or in any combination, render the claimed subject matter obvious under the standards of 35 U.S.C. § 103 as articulated by the BPAI and the Federal Circuit. Consequently, each of the obviousness rejections must be withdrawn.

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Russell in view of McConnell

As noted above, the Examiner rejected Claims 1-7, 9-15, 17-30, 32-37, 39-47, 50-64, 84, 85, 89, 91, and 95-100 as obvious over Russell in view of McConnell. However, the Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Specifically, the Applicants respectfully submit that the Examiner has not (i) presented any rational for ignoring the inconsistencies between the Russell and McConnell references, (ii) identified what part of which reference is being combined with what of the other reference, (iii) provided any objective teaching or suggestion to modify, (iv) provided evidence that there would have been a reasonable expectation that if the teaching of the reference were combined, it would be successful. Therefore, the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious and this rejection must be withdrawn.

Russell and McConnell cannot be combined because they are inconsistent

In the first instance, the Examiner alleges that the device disclosed by the Russell patent is a parallelogram linkage. Office Communication at 6 ("a parallelogram linkage (Figs. 20-21)"). In marked contrast, the Examiner recognizes that the device disclosed by the McConnell patent uses a non-parallelogram linkage. Office Communication at 8 ("providing a non-parallelogram linkage"). Despite the inconsistency between these two references, the Examiner alleges one of ordinary skill would have abandoned the advantages of the Russell patent to achieve the benefits of the claimed subject matter. The Applicants respectfully submit that the Examiner's unsupported assertion that one of

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ordinary skill would combine the references is insufficient to overcome the inconsistencies between the references.

Specifically, Russell teaches a device that keeps the "support platform" horizontal throughout its range of motion. For instance, Fig. 7 of the Russell patent shows the "support platform" in its raised extreme position. In that raised extreme position, the "support platform" is in a horizontal position. Fig. 1 of the Russell patent shows the "support platform" in an intermediate position. In that intermediate position, the "support platform" is in a horizontal position. Fig. 2 of the Russell patent shows the "support platform" in its lowered extreme position. In that lowered extreme position, the "support platform" is in a horizontal position. In sum, the Russell patent teaches that the "support platform" is kept horizontal.

This constant horizontal position of the Russell patent "support platform" was known to be a desirable attribute of such devices because, among known advantages, it reduced the probability that the keyboard would fall off of the platform during operation of the mechanism. See U.S. Patent No. 4,616,798 to Smeenge *et al.* col. 5, lines 34 - 44.

In marked contrast to the constant horizontal position of the Russell patent support platform, the device of the McConnell patent changes the orientation of the platform as the platform is raised or lowered. *E.g., compare* Fig. 2 of the McConnell patent *with* its Fig. 3.

Because of the inconsistencies between the Russell and the McConnell references, one cannot predict the orientation of the platform (in the lowered position) in the Examiner's combination. Indeed, the Examiner's failure to explain how her proposed combination would work is telling. She cannot explain how it would work because

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neither of the references provides any hint to how her amalgamation of these two inconsistent devices would work. Because the Russell and McConnell references are inconsistent, they cannot be combined to reject the claimed subject matter under 35 U.S.C. § 103. For this reason alone, the present rejection must be withdrawn.

*The Examiner has not identified what parts
of which references are combined*

In addition to the inconsistencies between the Russell and the McConnell patents, it is not clear what parts of the Russell patent the Examiner would combine with what parts of the McConnell patent. For instance, while the Examiner is correct some of the embodiments of the Russell patent have "a lower link/bar/side arm (15)", the Examiner ignores the embodiments of Russell Figs. 1 – 10 that do not have a lower link of the type shown in Figs. 20 -21. Moreover, the Examiner has not articulated any reason why one of ordinary skill would have selected only the latter embodiments shown in Russell. This lack of a teaching to choose the appropriate teaching of Russell illustrates the hindsight nature of the present rejection. As a result, the present rejection is improper and must be withdrawn.

There is no objected basis to combine Russell and McConnell

The Examiner has not identified any objective evidence that teaches or suggests combining the Russell and McConnell patents. Indeed, neither the Russell patent nor the McConnell patent provides any guidance as to what parts one of ordinary skill should pick from one patent to combine with what part of the other to make the claimed subject

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matter. Instead, the Examiner has relied upon the road map provided by the rejected claims. That however is hindsight, which is an improper basis for a rejection under 35 U.S.C. § 103.

"Where [as here] an invention is contended to be obvious based upon a combination of elements across different references, our cases require that there be a suggestion, motivation or teaching to those skilled in the art for such a combination." *Iron Grip Barbell Co. v. USA Sports Inc.* 73 USPQ2d 1225, 392 F3d 1317 (Fed. Cir. 2004) citing *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596 (Fed. Cir. 1988). As the Examiner has not identified any such teaching or suggestion, the rejection is improper and must be withdrawn.

In contrast to the absence of a reason to combine the Russell and McConnell patents, the Applicants provided several reasons why one of ordinary skill in the art would not have combined these references. For instance, the combination reduces the utility of the device, the combination would create a restriction in the knee hole, and the Examiner's proposed combination negates the objective of the Russell patent. However, the Examiner has not provided any rationale for why these reasons do not prevent combining these references.

In particular, McConnell describes a device with a limited utility, and as a result, any combination based upon this reference has a limited utility. The device of the McConnell patent rotates its support platform when the platform is lowered. Because of this rotation, the McConnell patent device may not be useful when in any position other than its fully raised position.

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For instance, a person who has his (or her) chair lowered may wish to use the device at the height of the fully lowered (but not retracted) device. However, because of the angled position of the support platform in that lowered position, the keyboard on a McConnell type device may not be unusable in the fully lowered device. As this reduces the utility of the alleged combination, the Applicants respectfully submit that this disadvantage negates any motivation to combine the Russell and McConnell references.

The device described by the McConnell patent creates a knee hole obstacle. For instance, when the device described by McConnell in its retracted position, *see e.g.* Fig. 2 of the McConnell patent, the support platform is rotated in the knee hole. Alternatively, when the device described in the McConnell patent is in the extended position, it has a large metal bracket under the support platform and in the knee hole. *See* Fig. 5. In either case, the device described by the McConnell patent was a device to be avoided and not emulated.

Moreover, the Examiner's proposed modification of the device of the Russell patent, changing the parallelogram linkage a non-parallelogram linkage, renders the device of the Russell patent not suitable for its intended purpose --

supporting a support platform for movement
relative to a base in a generally parallel orientation
through a plurality of positions.

Abstract of the Russell patent (emphasis added).

Because the asserted modification of the primary reference, Russell, renders the device unable to perform its intended function as it would here, namely of maintaining the horizontal position of the support platform, then combining it with the modifying reference, McConnell, that teaches away from the primary reference cannot be the basis

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of a *prima facie* showing of obviousness under 35 U.S.C. § 103. *E.g., Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 U.S.P.Q.2d 1294 (Fed. Cir. 1999). For this further reasoning, the present rejection is improper and must be withdrawn.

For any of the above-stated reasons, the present rejection lacks a proper basis and must be withdrawn.

*The Examiner has not shown that there was
a motivation to make the asserted
modification of the cited references*

One requirement for a rejection under 35 U.S.C. § 103 based on a combination of references is that there must be a motivation to make the asserted modification of the cited references. *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references."). The only proffer made in the present rejection is the bald, conclusory statement that it would have been obvious to make the claimed subject matter. That is an insufficient for the present rejection. Therefore, for this further reason, the present rejection must be withdrawn.

For each of the above-stated reasons, and others, the Examiner has not established a *prima facie* showing that the Russell patent can be combined – under the standard of 35 U.S.C. § 103 – with the McConnell patent to arrive at the claimed subject matter. In other words, the present rejection is improper and must be withdrawn.

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Russell in view of McConnell in further view of Cotterill

As noted above, the Examiner rejected Claims 16 and 38 as obvious over Russell in view of McConnell in further view of Cotterill.

The Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

In the first instance, this rejection compounds the problems addressed above by adding a further inconsistent reference. Thus, for each of the reasons stated above, this rejection is improper and must be withdrawn.

The Examiner alleges that the McConnell references teaches "means for adjusting the linkage and to facilitate adjustment to a desired angle and tilt with only one hand" Office Communication at 10. However, the support the Examiner cites for that proposition does not say what the Examiner asserts. Rather, the text the Examiner cites states:

Another object of the invention is to provide an improved keyboard platform support mechanism which includes an easily adjustable mechanism for altering the angle or tilt of the platform, and which also includes an easily adjustable and accessible mechanism for locking or holding the support linkage in a fixed position.

McConnell patent at col. 2, lines 42-50.

There is no mention of being able to adjust anything with one hand in that paragraph, or anywhere else in the McConnell patent. In other words, the Examiner has

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misconstrued the McConnell patent. For this reason alone, the Examiner has not set forth a *prima facie* showing that the claimed subject matter is obvious. Therefore the rejection must be withdrawn.

Moreover, while Cotterill has an elongate member with a longitudinal slot, the Applicants note that Cotterill's slot is located next to the auxiliary shelf bracket. *E.g.*, Cotterill's Fig. 1. In contrast, in those embodiments of Russell that have a slot, the slot is located away from the auxiliary shelf bracket. *E.g.*, Russell's Fig. 20. Furthermore, McConnell does not have a slot. In view of these mutually exclusive embodiments, how are these references to be combined? The Examiner has not shown any teaching that would guide one of ordinary skill, other than the rejected claims. That, again, is hindsight and is not an appropriate basis for rejecting the present claims. Therefore for this reason alone, the present rejection must be withdrawn.

Furthermore, while each of the references has four elongated members, Russell and McConnell each teach two elongated members on each side. In marked contrast, Cotterill has three elongated members on one side and one on the other side. If these references are combined, does the device have two elongated members on each side, three elongated members on one side and one on the other side, or some other combination? This question establishes that the cited art does not teach any combination of these references. Therefore, the rejection is improper and must be withdrawn.

For each of the above-stated reasons, and others, the Examiner has not established a *prima facie* showing that the Russell patent can be combined -- under the standard of 35 U.S.C. § 103 -- with the McConnell and Cotterill patents to arrive at the claimed subject matter. In other words, the present rejection is improper and must be withdrawn.

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Russell in view of Watt

As noted above, the Examiner rejected Claims 65-69 and 73 as obvious over Russell in view of Watt.

The Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

The Examiner acknowledges that the Russell patent "does not teach the shelf bracket (14) being pivotally connected to the front portion of the first/upper arm (16) by at least one pivot positioned above a shelving surface (at 14)". Office Communication at 15. However, the Examiner asserts that Watt teaches a pivot connection above the shelving surface. *Id.* Therefore, the Examiner concludes "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the articulating arm mechanism of Russell by providing a pivot connection between the first/upper arm and the shelf bracket located above the shelving surface as an alternative means for pivotally supporting the shelf bracket and as taught by Watt." *Id.* In other words, the Examiner is offering another serving of scrambled references.

However, the Examiner has not articulated any rational why one of ordinary skill would have made such a modification of the Russell patent. Nor has the Examiner identified which of the nine embodiments of the Russell patent the ordinarily skilled artisan would have chosen to modify in this manner. Rather, once again, the rejection feels like hindsight where the rejected claims are the only road map for arriving at the claimed subject matter.

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Furthermore, the Watt patent clearly shows that the bracket attached to the auxiliary shelf does so at the exterior of the shelf. In contrast, the subject matter of rejected Claim 65 calls for the bracket "to be mounted away from the outer side edges of the auxiliary shelf". Thus, for this further reason, the cited references teach away from the claimed subject matter, and do not render it obvious. Therefore, when the claimed invention as a whole is considered, the Examiner has not set forth a *prima facie* showing of obviousness. The rejection is improper and must be withdrawn.

As previously noted above, use of the rejected claims to guide the combination of elements to arrive at the claimed subject matter does not constitute a *prima facie* showing of obviousness. Here, the only road map for combining the elements from the prior art is the claim subject matter. Therefore, the rejection is improper and must be withdrawn.

Because the Examiner has not identified any objective teaching that would have lead one of ordinary skill to combine any embodiment of Russell with Watt, this rejection is improper and must be withdrawn.

Russell in view of Watt in further view of McConnell

As noted above, the Examiner rejected Claims 70-72 and 74-82 as obvious over Russell in view of Watt in further view of McConnell.

The Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

In addition to the fundamental problems of combining Russell with Watt mentioned above, the addition of the McConnell patent further renders the combination

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untenable. For instance, as the Examiner noted, McConnell rotates his shelf bracket when he lowers his device. Office Communication at 13 and 16. By rotating the shelf bracket, McConnell increases the distance between the height (from the floor) of the front end of the keyboard platform and the bottom of the shelf bracket. If one were to rotate the shelf bracket of Watt in this fashion, it is not clear that the rotated bracket and shelf platform would fit within storage box 12 (shown in Fig. 1 of Watt). In other words, the cited references are inconsistent and cannot be combined under the standard of 35 U.S.C. § 103 to support a rejection. Therefore the present rejection is improper and must be withdrawn.

Furthermore, the Examiner alleges that one of ordinary skill would add a swivel mechanism (ala McConnell) to the structure formed by scrambling Russell with Watt. The Applicants respectfully submit that while the device of McConnell can accommodate such a swivel mechanism, the device of Watt probably may not. Rather, if Watt were swiveled, the Applicants submit it would produce a substantial torque component that could break the mechanism. In other words, there is a substantial likelihood that the combination advocated by the Examiner would not be successful in its intended purpose. For this further reason, the present rejection is improper and must be withdrawn.

Watt in view of McConnell

As noted above, the Examiner rejected Claims 90 and 93 as obvious over Watt in view of McConnell.

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The Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

This set of scrambled references combines the parallelogram linkages of Watt (*e.g.*, col. 3, lines 64-67) with the non-parallelogram linkage of McConnell. As noted above, parallelogram linkages provide for a constant positioning of the platform whereas the non-parallelogram linkage of McConnell rotates the platform as it is raised or lowered. Thus, for this reason alone, the two references are inconsistent and cannot be combined to form a proper basis for a rejection of the claimed subject matter as obvious. Therefore, this rejection must be withdrawn.

The Applicants also note that McConnell discloses the use of cross-plate 62. *E.g.*, Fig. 6. Those of ordinary skill in the art know that articulated arm mechanisms with a cross-plate generally are relatively narrow – *i.e.*, the arm attaches to the shelf bracket away from the lateral edges of the keyboard platform. *See* U.S. Patent No. 4,616,798 to Smeenge *et al.* In marked contrast, the shelf bracket of the Watt device attaches to the articulated arms at the lateral edges of the keyboard platform. Fig. 3. Thus, the disclosure of these references is inconsistent as to the width of the shelf bracket and where the articulating arm attaches to the shelf bracket.

However, none of the cited references provides one of ordinary skill with guidance as to what part(s) of Watt should be scrambled with what part(s) of McConnell. Rather, the only road map for picking non-parallelogram arms and a narrow shelf bracket with articulating arms attaching to the shelf bracket away from the lateral edges of the

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keyboard being the rejected claims. That is hindsight and not a proper basis for rejecting the claim as obvious. Therefore the present rejection must be withdrawn.

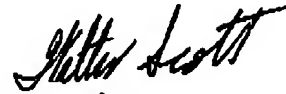
CONCLUSION

In view of the above amendments and remarks, the Applicants respectfully submit that they have obviated any reasonable basis for any of the rejections set forth in the Office Action of January 14, 2005. The Applicants therefore respectfully submit that the pending claims are in condition for allowance and respectfully solicit the same at an early date.

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It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

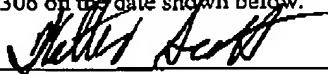


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